

## **REMARKS**

Applicant is in receipt of the Office Action mailed December 22, 2003. Claims 1-83 are pending and claim 83 was withdrawn by Examiner in the application prior to the present amendment. Claims 14, 18, 19, 47, 58, and 73 were objected to as being dependent upon a rejected base claim, but were otherwise stated to be allowable. Claims 74, 75, and 79 were allowed. Applicant respectfully thanks the Examiner for consideration of these claims. Reconsideration of the present case is earnestly requested in light of the following remarks.

Applicant is in the process of correcting the declaration regarding the indicated citizenship of inventor Ram Rajagopal, and will provide the corrected (supplemental) declaration as soon as it is received from the inventor.

### **37 C.F.R. 175 Objections**

Claims 1, 4-20, 42-47, 53, and 55-58 were objected to under 37 C.F.R. 175(a) as not particularly pointing out and distinctly claiming the subject matter with Applicant regards as the invention.

Applicant has amended various of the claims to particularly point out and distinctly claim various embodiments of the invention. Accordingly, Applicant respectfully submits that claims 1, 4-20, 42-47, 53, and 55-58 are allowable.

Removal of objections under 37 C.F.R. 175 of claims 1, 4-20, 42-47, 53, and 55-58 is respectfully requested.

### **35 U.S.C. 112 Rejections**

Claims 5-12, 44-46, 55-57, 64-71, 76-78, and 82 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Examiner states in the Office Action: "Claim 5 recites. . . There is thus confusion here, because as the steps are ordered, there is a second subset, second test results and a second criteria referred to before there is a first subset, first test results and a first criteria

that is for example we have test results being labeled as ‘second test results’ when in fact these ‘second test results’ occur before what is called ‘first test results’ but have not been referred to as ‘first test results’.”

Applicant respectfully submits that, for example, the labeling scheme for “second test results” occurs since claim 5 is dependent upon claim 1, and claim 1 already uses the label “first test results”. Accordingly, using “second subset”, “second test results”, and “second criteria” does not imply that the label of “second” implies a chronology; rather, it is used to differentiate items from what is already in claim 1 where the label of “first” has already been used. Applicant has amended claim 5 to more clearly and distinctly claim one or more embodiments of the invention. For example, claim 5 currently recited in pertinent part includes “. . .after (b) and before (c), pre-testing the curve against a second subset of the plurality of data points, wherein the second subset is a proper subset of the plurality of data points, wherein said pre-testing produces second test results. . .”

Claims 44 and 55 have been amended to include similar limitations to claim 5. Accordingly, Applicant respectfully submits that the reasons presented above apply with equal force to these claims, as well.

Claims 64, 76, and 82 have been amended as well.

Accordingly, Applicant respectfully submits that claims 5, 44, 55, 64, 76, and 82 and those respectively dependent thereon particularly point out and distinctly claim the subject matter of various embodiments of Applicant’s invention. Accordingly, Applicant respectfully submits that claims 5, 44, 55, 64, 76, and 82 and those respectively dependent thereon are allowable.

Removal of the §112 rejection of claims 5-12, 44-46, 55-57, 64-71, 76-78, and 82 is respectfully requested.

### **35 U.S.C. 102 Rejections**

Claims 1, 4, 13, 15-17, 42, 43, 53, 72, 80, and 81 were rejected under 35 U.S.C. 102(b) as being anticipated by Roth (U.S. Patent No. 5,617,491). This rejection is respectfully traversed.

As Examiner is certainly aware, “[a]n ‘anticipating’ reference must describe all of the elements and limitations of the claim in a single reference, and enable one of skill in the field of the invention to make and use the claimed invention. *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1378-79 (Fed. Cir. 2001); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989).” *In re Merck & Co., Inc. v. Teva Pharm. USA, Inc.*, 347 F.3d 1367, 1372 (Fed. Cir. 2003) (*emphasis added*).

Applicant respectfully submits that Roth tests all the data points in a plurality of data points. Otherwise, Roth could not categorize the inliers and the outliers:

Along with an equation of the best primitive, an extraction method determines which subset of the geometric data points belong to the primitive (the inliers) and ignores the rest (the outliers). The output of the primitive extraction process is the equation of the best primitive, along with a division of the input points into inliers and outliers. (Roth col 5, lines 45-51) (*emphasis added*)

In contrast, Applicant’s invention as currently recited in pertinent part by claim 1 includes “. . . testing the curve against a first subset of the plurality of data points, wherein the first subset is a proper subset of the plurality of data points, wherein said testing produces first test results. . .” Applicant respectfully notes that a proper subset is a subset that is not the entire set. Roth does not teach, suggest, or provide motivation for this feature. Therefore, Applicant respectfully submits that, at least for the reason presented, claim 1 is patentably distinguished over Roth. Accordingly, Applicant respectfully submits that claim 1 and those dependent thereon are allowable.

Claims 42, 72, 80, and 81 include limitations similar to claim 1, and so the arguments presented above apply with equal force to these claims 42, 72, 80, and 81, as well. Applicant respectfully submits that for at least the reason or reasons presented above, claims 42, 72, 80, and 81, and those claims respectively dependent thereon are patentably distinguished over Roth and are allowable.

Claim 53 includes limitations similar to claim 1, specifically, the feature “. . . test the curve against a first subset of the plurality of data points, to produce first test results,

wherein the first subset is a proper subset of the plurality of data points. . .”, and so the arguments presented above apply with equal force to claim 53, as well. Therefore, Applicant respectfully submits that, at least for the reason or reasons presented, claim 53 is patentably distinguished over Roth. Accordingly, Applicant respectfully submits that claim 53 and those dependent thereon are allowable.

Removal of the §102 rejection of claims 1, 4, 13, 15-17, 42, 43, 53, 72, 80, and 81 is respectfully requested.

### **35 U.S.C. 103 Rejections**

Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of Silver et al. (U.S. Patent No. 6,408,109, hereinafter “Silver”). This rejection is respectfully traversed.

As Examiner is aware, the MPEP §2143.03 states: “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”

Additionally, as held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. Moreover, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular . . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

As disclosed above, Applicant’s invention as currently recited in pertinent part by claim 1 includes “. . . testing the curve against a first subset of the plurality of data points,

wherein the first subset is a proper subset of the plurality of data points, wherein said testing produces first test results. . .” Roth does not teach, suggest, or provide motivation for this feature. Silver does not teach, suggest, or provide motivation for this feature. Applicant thus submits that neither Roth nor Silver provides or even hints at a motivation to combine, and thus, that combining Roth and Silver to establish the §103 rejection is improper.

Therefore, Applicant respectfully submits that, at least for the reasons presented, claim 1 is patentably distinguished over both Roth and Silver, taken both singly and in combination. Accordingly, Applicant respectfully submits that claim 1 and those dependent thereon are allowable. Since claim 20 depends from claim 1, Applicant submits that claim 20 is patentably distinct from the cited references, and is thus allowable for at least the reasons presented above. Removal of the §103 rejection of claim 20 is respectfully requested.

Applicant also respectfully asserts that numerous ones of the dependent claims recited further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150/52200/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Request for Approval of Drawing Changes
- ☐ Notice of Change of Address
- ☐ Check in the amount of \$            for fees (        ).
- ☐ Other:

Respectfully submitted,



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